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09/648,314	08/25/2000	Andrej Gregov	249768045US	6403

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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT

PAPER NUMBER

2171

DATE MAILED: 03/15/2004

13

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/648,314

Applicant(s)

GREGOV ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 25-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 27-35 is/are allowed.
- 6) ☒ Claim(s) 1-14, 17-20, 25 and 26 is/are rejected.
- 7) ☒ Claim(s) 15 and 16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 August 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Status:

Claims 21-24 and 36-39 are cancelled.

Claims 1-20 and 25-35 are pending.

Claim Objections

1. Claims 15 and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-8, 13, 14, 18-20, 25 and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Pub No US 2001/0049623 issued to Aggarwal (hereafter Aggarwal '623).

Regarding claims 1, 3, 4 and 25, Aggarwal '623 discloses:

- (a) receiving user input specifying a search string [Fig 5, 505]
- (b) performing a query of items matching the search string [second input – buying behavior/browsing behavior per paragraph 0061]

- (c) identifying among the items matching the search string a subset of most relevant items [product characterizations per paragraph 0061]
- (e) submitting the items identified in (c) to a recommendation engine [Fig 5, 510 – customer characterization per paragraph 0061]
- (f) receiving from the recommendation engine a set of recommended items based upon the items submitted in (e) [Fig 5, 550 peer group response, paragraph 0062].
- (g) displaying a list of recommended items comprising the items received from the recommendation engine in (e) and the items identified in (c) [Fig 1, 4]
- (h) receiving user input selecting one or more of the items displayed in (g) [paragraph 0017]

Regarding claim 2, Aggarwal '623 discloses a product available for purchase from a web merchant [abstract]

Regarding claim 5, Aggarwal '623 discloses: receiving an input string, performing a word search against the received input string to produce a word search result containing items and using items among the items contained by the word search result as seeds to generate a list of recommended items [Fig 5, 505, Fig 2, 230 and paragraph 0043]

Regarding claim 6, Aggarwal '623 discloses displaying the generated list of recommended items [Fig 1, 4]

Regarding claims 7 and 8, Aggarwal '623 discloses receiving user input modifying the list of seed items and using the modified list of seed items to generate a second list of recommended items [paragraph 0043].

Regarding claim 13, Aggarwal '623 discloses receiving a recommendation input string, performing a keyword search against the received input string to produce a search result

containing items and using among the items contained by the search result as seeds to generate a list of recommended items [paragraph 0043]

Regarding claim 14, Aggarwal '623 discloses displaying a plurality of item indications each indicating an item, receiving user input selecting one or more of the displayed item indications, selecting as seed items the items indicated by the selected item indications, generating a list of recommended items using the selected seed items and displaying the generated list of recommended items [paragraph 0043, Fig 1 and Fig 5]

Regarding claim 18, Aggarwal '623 discloses a display that displays a plurality of item indications each indicating an item, an input receiver that receives user input selecting one or more of the displayed item indicators, a seed selection subsystem that selects as seed items the items indicated by the selected item indications, and a recommended item list generator that generates a list of recommended items using the selected seed items that is displayed by the display [paragraph 0043 and Fig 1]

Regarding claims 19 and 20, Aggarwal '623 discloses one or more computer memories collectively containing a recommendation seed data structure comprising one or more recommendation seed entries, each recommendation seed entry identifying an item expressly specified by a user as a basis for an item recommendation, such that the contents of the data structure may be submitted to a recommendation engine to generate a list of recommended items based upon the items identified by the recommendation seed entries [Fig 1, paragraph 0043]

Regarding claim 26, Aggarwal '623 discloses receiving user modifications to the user-specified recommendation seed base, modifying the user-specified recommendation seed base in

accordance with the received user modifications and using the modified user-specified recommendation seed base to produce a second list of recommended items [paragraph 0043]

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 9-12 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aggarwal '623 as applied to claim 9 above, and further in view of Pub No 2002/0154157 issued to Sherr et al (hereafter Sherr '157)

Regarding claims 9 and 11, Aggarwal '623 discloses the essential elements of the claimed invention as noted above except for e-mailing the generated list to the user. Sherr '157 discloses e-mailing the generated list to the user [Paragraph 0074]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Aggarwal '623 to

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incorporate e-mailing the generated list to the user as taught by Sherr '157 for the purpose of providing a quick and convenient notification at the client's desktop [Aggarwal '623, Fig 1]

Regarding claim 10, Aggarwal '623 discloses purchasing [paragraph 0023]

Regarding claim 12, Aggarwal '623 discloses an HTTP request [paragraph 0037]

Regarding claim 17, Aggarwal '623 discloses the essential elements of the claimed invention except for wherein the displayed plurality of item indications are contained in a first electronic mail message to a user, and wherein the user input is contained in a response to the first electronic mail message from the user, and wherein the generated list of recommended items is contained in a second electronic message to the user. Examiner maintains an electronic mail message is well-known and expected in the art [paragraph 0074]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Aggarwal '623 to include above limitation for the purpose of providing a quick and convenient notification at the client's desktop [Aggarwal '623, Fig 1]

Allowable Subject Matter

Claims 15 and 16 are allowable for including wherein none of the set of seed items is a rated item having a rating in the user profile.

Claims 27-35 are allowable for including when a displayed control is selected by a user, adding to a list of recommendation seeds products in the group in conjunction with which the selected control is displayed so that the list of recommendation seeds contains products in the groups whose controls are selected by the user.

Response to Arguments

Applicant's arguments filed 1/12/2004 have been fully considered but they are not persuasive.

First Applicant Argument:

Applicant states on page 12 "First Aggarwal does not disclose receiving a search string directly specified by a user."

First Examiner Response:

Examiner is not persuaded. Aggarwal discloses the following in paragraph 60:

Turning now to FIG. 5, a flowchart illustrating how the process responds to various queries corresponding to customer requests is provided (step 240, FIG. 2). FIG. 5 defines the on-line query stage. It is important to note that each of the process steps illustrated in FIG. 5 are described with regard to a single customer request. It can be appreciated, however, that the method can accommodate, on a first come first serve basis, a plurality of requests from one or more customers.

Examiner maintains that Aggarwal does in fact disclose the claim 1 limitation "receiving user input specifying a search string."

Second Applicant Argument:

Applicant states on page 13 "Second, Aggarwal does not disclose conducting a word search based upon such an input string, as recited by these claims."

Second Examiner Response:

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., conducting a word search based upon such an input string) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations

from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Third Applicant Argument:

Applicant states in the second paragraph on page 13 “Third, Aggarwal does not disclose submitting items – identified by a word search or otherwise – as recommendation seeds.”

Third Examiner Response:

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., submitting items – identified by a word search or otherwise – as recommendation seeds) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Fourth Applicant Argument:

Applicant states in the second paragraph on page 13 “Applicant submits that comparing such characterizations -- which are simply not items, but rather sets of words appearing in product descriptions – does not constitute submitting items as recommendation seeds as recited by these claims.”

Fourth Examiner Response:

Examiner is not persuaded. Since Applicant has not positively identified the claim nor the limitation of a claim in above argument, examiner is unable to respond in detail. In particular, the language “submitting items as recommendation seeds” is not included in claim 1.

Fifth Applicant Argument:

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Applicant states in the third paragraph on page 13 “The Examiner rejected claims 14-20, 25 and 26 over Aggarwal, either alone or in combination with Starr. These claims are directed to generating recommendations using a user-specified recommendation seed base comprised of seed items, and using the seed base to produce a list of recommended items. Nowhere does Aggarwal disclose receiving such a seed base, or using it to produce a list of recommended items. It is not clear how Figure 1 or paragraph 43 of Aggarwal, identified by the Examiner, could possibly relate to these claim elements.”

Fifth Examiner Response:

Examiner is not persuaded. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., These claims are directed to generating recommendations using a user-specified recommendation seed base comprised of seed items, and using the seed base to produce a list of recommended items) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Sixth Applicant Argument:

Applicant states in the paragraph linking pages 13 and 14 “The Examiner rejected claims 9-12 and 17 under 35 U.S.C. § 103 over Aggarwal and Sherr. These claims each recite sending an email to a user containing a list of items recommended for the user. The Examiner indicated that Sherr discloses sending such an email in paragraph 74. This paragraph of Sherr does not disclose sending such an email. Rather, it merely discusses using user responses to inquiries or a

questionnaire that are received from the user via electronic mail to generate recommendations for the user.”

Sixth Examiner Response:

Examiner is not persuaded. Examiner used an obviousness rejection and thus it would have been obvious to one of ordinary skill in the art to send and receive emails as desired.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne LeRoux whose telephone number is (703) 305-0620. The examiner can normally be reached on Monday – Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached on (703) 308-1436.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Etienne LeRoux

3/11/2004



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